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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,718	02/24/2004	Mark Banister	MEDIPACS 04.03	2762
27667	7590	05/05/2010		
HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				
EXAMINER				
FREAY, CHARLES GRANT				
ART UNIT		PAPER NUMBER		
3746				
NOTIFICATION DATE		DELIVERY MODE		
05/05/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

admin@hayes-soloway.com  
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### Office Action Summary

**Application No.**

10/786,718

**Applicant(s)**

BANISTER, MARK

**Examiner**

Charles G. Freay

**Art Unit**

3746

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,5-21 and 24-62 is/are pending in the application.
- 4a) Of the above claim(s) 8-12,16,18,27-57 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-7,15,17,19-21,24-26 and 58-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drafts/Person's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to the amendment of March 29, 2010. The examiner has considered each of the applicant's arguments. The rejections and remarks set forth below address each of the arguments.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 3, 15, 17, 19-21, 24-26 and 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over da Costa in view of Chinn et al as set forth in the rejection of claims 1-4, 15, 17, 19-21 and 24-26 of the Office Action of July 1, 2009.

The examiner notes that the intended use set forth in the preamble of the claims does not define the invention over the applied references. Further defining the fluid which is intended to be pumped by the claimed pump also does not structurally define or differentiate the claimed from the applied prior art references.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over da Costa in view of Chinn et al as applied to claim 59 above, and further in view of Culp (USPN 5,192,197).

As set forth above da Costa in view of Chinn disclose the invention substantially as claimed but does not disclose a programmable microprocessor responsive to a

sensor measuring flow properties and delivering control signals to the electroactuated pump actuators. Culp discloses a pump having an actuator housing 22 for accommodating fluid flow. There are a number of individual electroactuated actuators forming a pump and there is an activator including a controller which is responsive to pressure, temperature and flow signals from a sensor 40. The controller is a programmable 36, 38 microprocessor for controlling the actuation at a predetermined time and rate. At the time of the invention it would have been obvious to one of ordinary skill in the art to provide the pump of da Costa et al in view of Chinn to provide a microprocessor controller and sensor system as taught by Culp in order to strictly and accurately control actuation of the pump and control flow rates and delivery volumes.

### ***Response to Arguments***

Applicant's arguments filed March 29, 2010 have been fully considered but they are not persuasive.

The applicant argues that the neither Culp nor da Costa teach of reversibly responsive elastomeric material. While this may be true the examiner respectfully disagrees that the proposed rejection does not make the claimed invention obvious. As noted in the rejection under 35 USC 103 Chinn et al disclose that the actuator is an electroactuated polymer gel (i.e. a reversibly responsive elastomeric element, see paragraph [0024] of the USPAP 2004/0234401 which is the publication of the current application).

The applicant also argues that the combination of da Costa and Chinn does not teach the individual actuators being arranged *contiguously*. The applicant provides an analysis of Chinn reference which ignores or discounts the teachings of the base da Costa reference. The examiner must again respectfully disagree. As set forth in "The American Heritage Dictionary, Second College Edition" Contiguous is defined as: nearby, neighboring or adjacent. The actuator arrangement taught and shown by da Costa (see Figs. 1a-1f) clearly disclose this feature.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles G Freay/  
Primary Examiner  
Art Unit 3746

CGF  
May 1, 2010